

Remarks

Claims 1-28 are pending in the application. Claim 28 has been withdrawn from consideration. Claims 8, 13, 18, and 21 have been amended. New claims 29-31 have been added to the application. Re-examination and reconsideration of the application is respectfully requested for the reasons set forth herein.

1. The Examiner has rejected claim 18 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 18 has been amended to clarify the claimed subject matter. Removal of the rejection of claim 18 under 35 U.S.C. 112, second paragraph, is respectfully requested.

2. The Examiner has rejected claims 8-11, 13-19, 21-23, and 26-27 under 35 U.S.C. 102(e) as being anticipated by Kakimoto et al. (U.S. Patent No. 6,602,586).

With regard to claims 8, 13, and 21, the Examiner stated that Kakimoto et al. discloses a substrate comprising a continuous sheet 2 for use in a flooring system having a subfloor and a decorative upper layer. A top surface of the substrate and an oppositely facing bottom surface of the substrate are essentially parallel to each other and are spaced apart by a thickness of about 10mm (column 4, lines 2-4). The substrate has a density of less than 1000 kilograms per meter cubed (column 5, lines 25-27). The substrate has voids provided between particles of rubber so that when the substrate is positioned between the subfloor and the decorative top layer, the particles of rubber provide the strength required to prevent deformation of the substrate in the direction of the thickness and the voids are inherently capable of contributing to the sound

dampening characteristics that will provide decibel reduction across the thickness of the structure. The Examiner, therefore, concluded that Kakimoto et al. teaches all of the elements of claims 8, 13, and 21.

a. Claim 8 has been amended to recite that the substrate comprises a sheet having a bottom surface configured for frictional interface with the subfloor and a top surface configured for receiving the decorative upper layer. As discussed in column 3, lines 34-57 and shown in Figure 1 of Kakimoto et al., Kakimoto et al. teaches an elastic block 1 having a powdery rubber-containing layer 2 adhered to a vulcanized rubber layer 3. The vulcanized rubber layer 3 is positioned adjacent to an underlying base to prevent upward warping when water enters the powdery rubber-containing layer 2, and the powdery rubber-containing layer 2 is positioned toward the atmosphere. Because the powdery rubber-containing layer 2 of Kakimoto et al. does not have a bottom surface configured for frictional interface with the subfloor and a top surface configured for receiving the decorative upper layer, Kakimoto et al. does not teach all of the elements of amended claim 8. Removal of the rejection of claim 8 under 35 U.S.C. 102(e) is respectfully requested.

Claims 9-11 depend from independent claim 8. As previously discussed, Kakimoto et al. does not teach all of the elements of claim 8. Because Kakimoto et al. does not teach all of the elements of claim 8, Kakimoto et al. does not teach all of the elements of claims 9-11. Removal of the rejection of claims 9-11 under 35 U.S.C. 102(e) is respectfully requested.

b. Claim 13 has been amended to recite that the substrate comprises a continuous sheet having a bottom surface frictionally interface with the subfloor and a top surface configured for receiving the decorative upper layer. As previously discussed, Kakimoto et al teaches an elastic block 1 having a vulcanized rubber layer 3 positioned adjacent to an

underlying base to prevent upward warping when water enters the powdery rubber-containing layer 2, and a powdery rubber-containing layer 2 positioned toward the atmosphere. Because the powdery rubber-containing layer 2 of Kakimoto et al. does not have a bottom surface frictionally interfaced with the subfloor and a top surface configured for receiving the decorative upper layer, Kakimoto et al. does not teach all of the elements of amended claim 13. Additionally, the Removal of the rejection of claim 13 under 35 U.S.C. 102(e) is respectfully requested.

Claims 14-19 and 26 depend from independent claim 13. As previously discussed, Kakimoto et al. does not teach all of the elements of amended claim 13. Because Kakimoto et al. does not teach all of the elements of amended claim 13, Kakimoto et al. does not teach all of the elements of claims 14-19 and 26. Removal of the rejection of claims 14-19 and 26 under 35 U.S.C. 102(e) is respectfully requested.

c. Claim 21 has been amended to recite that the substrate comprises a sheet having a bottom surface configured for frictional interface with the subfloor and a top surface configured for receiving the decorative upper layer. As previously discussed, Kakimoto et al teaches an elastic block 1 having a vulcanized rubber layer 3 positioned adjacent to an underlying base to prevent upward warping when water enters the powdery rubber-containing layer 2, and a powdery rubber-containing layer 2 positioned toward the atmosphere. Because the powdery rubber-containing layer 2 of Kakimoto et al. does not have a bottom surface configured for frictional interface with the subfloor and a top surface configured for receiving the decorative upper layer, Kakimoto et al. does not teach all of the elements of amended claim 21. Removal of the rejection of claim 21 under 35 U.S.C. 102(e) is respectfully requested.

Claims 22-23 and 27 depend from independent claim 21. As previously discussed, Kakimoto et al. does not teach all of the elements of claim 21. Because Kakimoto et al. does not

teach all of the elements of claim 21, Kakimoto et al. does not teach all of the elements of claims 22-23 and 27. Removal of the rejection of claims 22-23 and 27 under 35 U.S.C. 102(e) is respectfully requested.

3. The Examiner has rejected claims 1-7 under 35 U.S.C. 103(a) as being unpatentable over Ducharme (US Patent No. 6,213,252) in view of Kakimoto et al. (US Patent No. 6,602,586).

With regard to claim 1, the Examiner stated that Ducharme teaches a flooring system comprising a substrate 10 with a bottom surface positioned proximate a subfloor 22 and a top surface positioned proximate a decorative top layer 20. The substrate 10 has a thickness of about 10mm and is manufactured from rubber to form a sheet, which is cut to fit a desired configuration. Ducharme does not disclose that the substrate has voids located between the particles of rubber that extend between the top and bottom surfaces. The Examiner further stated that Kakimoto et al. teaches a substrate having voids that extend between top and bottom surfaces. The Examiner, therefore, concluded that it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the sound absorbing rubber particle sheet of Kakimoto et al. for the sound absorbing rubber particle sheet of Ducharme, because both sheets will absorb the sound that is produced from walking on the floor.

Kakimoto et al. is not properly combinable with Ducharme, because to substitute the powdery rubber-containing layer 2 of Kakimoto et al. for the substrate 10 of Ducharme would destroy the intended function of the substrate 10. Additionally, there is no basis in the art for combining or modifying Ducharme with Kakimoto et al. As discussed in column 1, lines 49-51, Ducharme teaches a substrate 10 for use as an underlayer in a flooring structure for absorbing acoustic sound, e.g., television, radio, speech, etc. The substrate 10 has a plurality of cavities 16

and is vulcanized and forced under pressure to be continuous. Because the substrate 10 is vulcanized, the substrate 10 does not have voids. The substrate 10, therefore, is incompressible and has the strength characteristics to be positioned between a top floor 20 and a subfloor 22 without additional support members. As discussed in column 2, lines 6-7, Kakimoto et al. teaches an elastic block 1 for absorbing impacts. As discussed in column 3, lines 43-46 of Kakimoto et al., the elastic block 1 consists of a powdery rubber-containing layer 2 that has a plurality of voids. Because the voids make the powdery rubber-containing layer 2 compressible, the powdery rubber-containing layer 2 needs to be integrated with a vulcanized rubber layer 3 to maintain stability. If the substrate 10 of Ducharme, therefore, was modified to have voids like the powdery rubber-containing layer 2 of Kakimoto et al., the substrate 10 would be compressible and would not have the strength characteristics required to be positioned between the top floor 20 and the subfloor 22 without the use of additional support members, which would destroy the intended function of the substrate 10. Additionally, because the substrate 10 of Ducharme is used for absorbing acoustic sound and the elastic block 1 of Kakimoto et al. is used for absorbing impacts, not only is there no basis in the art for the combining or modifying the references, but modifying the substrate 10 of Ducharme to have voids would destroy the intended acoustic absorbing properties of the substrate 10.

Further, Ducharme teaches away from the Examiner's modification. In column 3, lines 23-27, Ducharme teaches the substrate 10 as being waterproof. Ducharme, therefore, teaches away from modifying the substrate 10 to have voids as taught by Kakimoto et al., because such a modification would make the substrate 10 water permeable.

For the aforementioned reasons, Kakimoto et al. is not properly combinable with Ducharme, there is no basis in the art for combining or modifying Ducharme with Kakimoto et

al., and Ducharme teaches away from the Examiner's modification. Removal of the rejection of claim 1 under 35 U.S.C. 103(a), therefore, is respectfully requested.

Claims 2-7 depend from independent claim 1. As previously discussed, Ducharme does not teach all of the elements of claim 1. Because Ducharme does not teach all of the elements of claim 1, Ducharme does not teach or suggest all of the elements of 2-7, except for the substrate having voids that extend between the top and bottom surfaces. The combination of Ducharme in view of Kakimoto et al., therefore, does not teach or suggest all of the elements of claims 2-7. Removal of the rejection of claims 2-7 under 35 U.S.C. 103(a) is respectfully requested.

4. The Examiner has rejected claims 12, 20, and 24-25 under 35 U.S.C. 103(a) as being unpatentable over Kakimoto et al. (U.S. Patent No. 6,602,586)

With regard to claims 12, 20, and 24, the Examiner stated that Kakimoto et al. discloses the claimed invention as previously discussed, except for the sound dampening characteristics exhibiting a decibel reduction of approximately 20 dB for a substrate with a thickness of 5 mm. The Examiner further stated that it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the substrate of Kakimoto et al. have a decibel reduction of 20 dB for a substrate of 5 mm, because it has been held that where the general conditions of a claim are disclosed in the prior art discovering the optimum or workable ranges involves only routine skill in the art. With regard to claim 25, the Examiner stated that Kakimoto et al. discloses the claimed invention as previously discussed, except that the rubber is formed from a cylindrical member. The Examiner further stated that the product of the process defined in the claim limitation is the same as or obvious from the product of Kakimoto et al. and, therefore, claim 25 is unpatentable.

Claim 12 depends from independent claim 8. As previously discussed, Kakimoto et al. does not teach all of the elements of claim 8. Because Kakimoto et al. does not teach all of the elements of claim 8, Kakimoto et al. does not teach or suggest all of the elements of claim 12. Removal of the rejection of claim 12 under 35 U.S.C. 103(a) is respectfully requested.

Claim 20 depends from independent claim 13. As previously discussed, Kakimoto et al. does not teach all of the elements of claim 13. Because Kakimoto et al. does not teach all of the elements of claim 13, Kakimoto et al. does not teach or suggest all of the elements of claim 20. Removal of the rejection of claim 20 under 35 U.S.C. 103(a) is respectfully requested.

Claim 24 depends from independent claim 21. As previously discussed, Kakimoto et al. does not teach all of the elements of claim 21. Because Kakimoto et al. does not teach all of the elements of claim 21, Kakimoto et al. does not teach or suggest all of the elements of claim 24. Removal of the rejection of claim 24 under 35 U.S.C. 103(a) is respectfully requested.

Claim 25 depends from independent claim 1. As previously discussed, Kakimoto et al. does not teach all of the elements of claim 1. Because Kakimoto et al. does not teach all of the elements of claim 1, Kakimoto et al. does not teach or suggest all of the elements of claim 25. Removal of the rejection of claim 25 under 35 U.S.C. 103(a) is respectfully requested.

5. Dependant claims 29-31 have been added to the application.

Claims 29-31 are considered to be in condition for allowance because the prior art fails to teach or suggest the claim limitations of each of the dependant claims in combination with their base claims.

Examination of claims 29-31 is respectfully requested.

In view of the arguments and amendments presented herein, the application is considered to be in condition for allowance. Reconsideration and passage to issue is respectively requested.

Attached is a check in the amount of \$54.00 for the addition of three (3) dependent claims. Please charge any additional fees associated with this application to Deposit Order Account No. 501581.

Respectfully submitted,
Paul Charles Downey, Applicant

A handwritten signature in cursive script, appearing to read "J M Slonaker", written over a horizontal line.

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